

REMARKS

In the March 7, 2006 Office Action, the Examiner noted that claims 1-8 were pending in the application; objected to claims 1-4 and 6-8; rejected claims 1, 4 and 5 under 35 USC § 101 and the second paragraph of 35 USC § 112; and rejected claims 1-8 under 35 USC § 102(e) as anticipated by U.S. Patent 6,510,434 to Anderson et al. Claims 3-7 have been canceled and claims 9 and 10 have been added. Thus, claims 1, 2 and 8-10 remain in the case. The Examiner's rejections are traversed below.

Objections to Claims

In items 2-7 on pages 2-3 of the Office Action, the Examiner objected to claims 1-4 and 6-8 due to alleged informalities. Since claims 3, 4, 6 and 7 have been canceled, the objections to these claims are moot. The objections to claims 1, 2 and 8 will be addressed below.

In item 3 the prepositional phrase "for extracting information" (presumably from the preamble of claim 1) was discussed with the conclusion that it carries "no patentable weight." It is noted that U.S. Patent Examiners typically give no patentable weight to statements in preambles, despite the line of decisions such as *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478 (CCPA 1951); *in re Fritch*, 972 F. 2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992), etc. Furthermore, use of the preposition "for" in the preamble of patent claims is customary and the rule of no patentable weight being given to the use of this term applies to limitations in the body of claims, not the preamble. Therefore, withdrawal of the objection or acknowledgement that the objection is irrelevant to the examination of claim 1 is respectfully requested.

In item 5, the Examiner objected to claim 2 due to a second occurrence of "an XML format" after previous occurrence of these words in claim 1 from which claim 2 depends. Claim 2 has been amended to recite "the XML format". Therefore, withdrawal of the objection is respectfully requested.

In item 7, the Examiner objected to claim 8 due to the use of the indefinite article at the beginning of the claim. The Examiner questioned whether "a new method separate from the preceding takes place after the initial process or if the claim ... [is] meant to be independent". The Examiner is respectfully requested to cite any requirement in U.S. patent law that dependent claim should be begin with the definite article. It is submitted that a new method is being recited in claim 8, i.e., one which differs from claim 10 (from which claim 8 now depends) due to the additional limitations recited in claim 8. It is submitted that the objection of claim 8 is improper for lacking any basis in U.S. patent law and withdrawal of the objection is respectfully requested.

Rejections under 35 USC § 101

In items 10-12 on pages 3-5 of the Office Action, claims 1, 4 and 5 were rejected under 35 USC § 101 as directed as non-statutory subject matter. Claims 4 and 5 have been canceled and therefore the rejections of these claims are moot. In rejecting claim 1, it was asserted that the "preamble recited 'an information extracting device for' performing a functionality without ever mentioning the 'device' as being a tangible computer device storing [a] software program 'executed' or 'processed' to realized the intended functionality". In response, claim 1 has been amended to recite "a user terminal ... and a server" as described in the specification. Thus, hardware components are now recited in claim 1. Withdrawal of the rejection of claim 1 under 35 USC § 101 is respectfully requested.

New claims 9 and 10 have been added reciting a computer-readable storage medium and a method, which were the subject matter of claims 4 and 5, respectively. Claim 9 includes the word "executed" as discussed in item 11 of the Office Action and claim 10 includes the operation of "returning results in the extensive mark-up language format from the function to the application software" as previously recited at the end of claim 6. Since claim 6 was not rejected under 35 USC § 101, it is submitted that claim 10 meets the requirements of 35 USC § 101 for the same reasons as claim 6 did. Withdrawal of the rejections of claims 9 and 10 under 35 USC § 101 is respectfully requested.

Rejections under 35 USC § 112, Second Paragraph

In items 14-17 on pages 5-7 of the Office Action, claims 1, 4 and 5 were rejected under the second paragraph of 35 USC § 112 "as being incomplete for omitting essential steps". Claim 1 was included in this rejection, even though claim 1 is a device or a system claim and thus, there are no steps recited and no basis for a rejection of claim 1 as lacking essential steps. Therefore, withdrawal of the rejection of claim 1 under the second paragraph of 35 USC § 112 is respectfully requested.

As noted above, claims 4 and 5 have been canceled and therefore the rejection of these claims is moot. If the Examiner finds any failure to meet the requirements of first or second paragraph of 35 USC § 112 in new claims 9 and 10 or claim 1 for a reason different than that stated in the March 7, 2006 Office Action, the Examiner is respectfully requested to contact the undersigned by telephone prior to issuing another Office Action, to schedule an Examiner Interview for the purpose of discussing what further amendment of the claims is necessary to prevent a rejection under 35 USC § 112.

In item 18 on page 7 of the Office Action, claims 2 and 3 were rejected under the second paragraph of 35 USC § 112 due to the lack of antecedent basis for the limitation "the generated requests in an XML format". Claim 3 has been canceled and claim 2 has been amended so that this phrase no longer appears. Withdrawal of the rejection is respectfully requested.

Rejections under 35 USC § 102

In item 20 on pages 8-10 of the Office Action, claims 1-8 were rejected under 35 USC § 102(e) as anticipated by Anderson et al. Claims 3-7 have been canceled and claim 8 now depends from claim 10. Therefore, the rejection of these claims is moot. The amendments made to claim 1 clarify that the request is sent from "a user terminal executing a browser" (claim 1, line 3) and the request is operated on by "a server executing application software, installed via the network, processing the request from the browser and XML processing called up from the application software, for receiving the request from the application software, converting the request into an XML format" (claim 1, lines 5-8), etc. Nothing has been cited or found in Anderson et al. that teaches or suggests a system including a user terminal and a server, like that now recited in claim 1. Therefore, withdrawal of the rejection of claim 1, as well as claim 2 which depends therefrom, is respectfully requested.

New Claims

Claims 9 and 10 have been added to recite operations performed as described in the specification. In claim 9, "instructions ... [are] executed [to] control at least one server" (claim 9, lines 1-2) to receive "a request from a user terminal to retrieve data from an information database" (claim 9, line 3), "extract ... information corresponding to the request from the information database" (claim 9, line 7) after "converting the request into an extensible markup language format by executing a function called up from application software and referencing a conversion database" (claim 9, lines 5-6) and "returning results of said extracting ... to the application software" (claim 9, last two lines). Similar limitations are recited in claim 10 which is directed to a "method for extracting information from a database" (claim 10, line 1). It is submitted that Anderson et al. does not include all of the recited operations. Therefore, it is submitted that claims 9 and 10 patentably distinguish over Anderson et al.

Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-2 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 7, 2006
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